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In The

Supreme Court of the United States

PELLA CORPORATION AND
W.L. GORE & ASSOCIATES, INC.,

Petitioners,

v.

ANDERSEN CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

HARRY C. MARCUS
JESSICA L. COPELAND
LOCKE LORD BISSELL & LIDDELL LLP
3 World Financial Center
New York, NY 10281
(212) 415-8600
Counsel for Petitioner W.L. Gore & Associates, Inc.

CALVIN L. LITSEY
JAMES W. PORADEK
AARON D. VAN OORT
Counsel of Record
SHAWN T. GORDON
ALEXANDER E. ZUMBULYADIS
FAEGRE & BENSON LLP
90 South Seventh Street
Minneapolis, MN 55402
(612) 766-7000
Counsel for Petitioner Pella Corporation

QUESTION PRESENTED

In U.S. Patent No. 6,880,612, Andersen Corporation claimed to have invented a less visible insect screen for use in doors and windows. Both lower courts found it undisputed that the claimed screen could have been made at the time simply by taking commercially available wire screening and painting it black. The district court granted summary judgment holding the patent invalid as obvious under 35 U.S.C. § 103. The Federal Circuit, however, applying the same "rigid approach" to obviousness that this Court rejected in *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398 (2007), reversed the district court's judgment, finding issues of fact that precluded summary judgment. 300 Fed. App'x 893.

The question presented for review is:

Did the Federal Circuit err by using the same factors that this Court rejected as part of the obviousness analysis in *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398 (2007), to limit the scope of the prior art that can be considered in that analysis?

RULE 14.1(b) AND RULE 29.6 STATEMENT

Petitioner Pella Corporation has no parent company, and no publicly held company owns 10% or more of Pella Corporation's stock.

Petitioner W.L. Gore & Associates, Inc. has no parent company, and no publicly held company owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

OPINIONS BELOW

The unpublished opinion of the court of appeals (App. 1-19) is reported at 300 Fed. App'x 893. The order denying rehearing and rehearing en banc (App. 43-44) is unpublished. The opinion of the district court (App. 20-32) is reported at 500 F. Supp. 2d 1192.

JURISDICTION

The court of appeals' judgment was entered on November 19, 2008. Petitioners filed a timely petition for rehearing and rehearing en banc. The petition was denied on December 30, 2008. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTE INVOLVED

The statute involved in this petition is 35 U.S.C. § 103(a), which provides that a patent may not issue for an invention that would have been obvious to a person of ordinary skill in the art:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

> ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

This case is a candidate for summary disposition under this Court's Rule 16.1 because the factual record is undisputed and every legal reason that the Federal Circuit offered for vacating the district court's grant of summary judgment of obviousness directly conflicts with this Court's decision in *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398 (2007). Because of the Federal Circuit's unique role in resolving appeals involving patent law, 28 U.S.C. § 1295(a)(1), the Court's grant of review in this case will affect every patent case in the United States in which obviousness is asserted.

A. This Court's Obviousness Law

In 2006, this Court granted review in *KSR* to "reject[ ] the rigid approach of the Court of Appeals" to patent law's obviousness doctrine, to reiterate the Court's own "expansive and flexible approach," and to restore the proper role of summary judgment in resolving obviousness challenges. 550 U.S. at 415.

Obviousness "is a legal determination," *id.* at 427, that rests on underlying issues of objective fact. In *Graham* v. *John Deere Co. of Kansas City*, 383 U.S.

1 (1966), the Court identified three primary factors that courts must assess to determine whether an invention was obvious at the time it was made: "the scope and content of the prior art," the "differences between the prior art and the claims at issue," and "the level of ordinary skill in the pertinent art." *Id.* at 17. Courts may also consider, if present, "commercial success, long felt but unsolved needs, [and] failure of others" to "give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.* at 17-18.

Through the years, this Court has repeatedly cautioned that inventions made from a combination of existing prior art are particularly likely to present questions of obviousness. As the Court has warned, granting patents "to advances that would occur in the ordinary course without real innovation retards progress," *KSR*, 550 U.S. at 419, by "withdraw[ing] what is already known into the field of [the patent's] monopoly and diminish[ing] the resources available to skillful men." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152-53 (1950). Thus, in *Great Atlantic*, the Court held that a "patent for a combination which only unites old elements with no change in their respective functions" is invalid as obvious. Similarly, in *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 282 (1976), the Court held that a patent which "simply arranges old elements with each performing the same function it had been known to perform" and produces no unexpected results is invalid as obvious.

Beginning in the 1980s, however, the Federal Circuit took a sharply different approach to combination patents. It established a rule that a patent claim for a combination of prior art could be proved obvious only if "some motivation or suggestion to combine the prior art teachings" was expressly contained in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. *See KSR*, 550 U.S. at 407 (*citing Al-Site Corp.* v. *VSI Int'l, Inc.*, 174 F.3d 1308, 1323-24 (CAFed 1999)).

This Court expressly "reject[ed] the rigid approach of the Court of Appeals" to obviousness in its decision in *KSR*. *Id.* at 415. The Court instructed that the objective analysis outlined in its *Graham* decision "continue[s] to define the inquiry that controls." *Id.* at 407. And it reiterated its warning that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416.

To correct the course of obviousness law, the Court identified several specific "errors" in the Federal Circuit's obviousness analysis and announced the correct rules for the Federal Circuit to follow. First, the Court held that courts "*need not* seek out precise teachings directed to the specific subject matter of the challenged claim" in determining whether it would be obvious to combine items of the prior art to make a claimed invention. 550 U.S. at 418 (emphasis added). "Under the correct analysis," the Court held, "any need or problem known in the field of endeavor at the time of invention and addressed by the patent can

provide a reason for combining the elements in the manner claimed," *id.* at 420, because courts "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ," *id.* at 418. Second, the Court held it an "error" to assume "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." *Id.* at 420. Instead, "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes." *Ibid.* Third, the Court held that, in assessing obviousness, what matters is not the subjective motivation of the patentee, but instead "the objective reach of the claim. If the claim extends to what is obvious it is invalid under § 103." *Id.* at 419.

Finally, the Court expressly "disagree[d]" with the Federal Circuit's reluctance to grant summary judgment on obviousness challenges. *Id.* at 427. Because "[t]he ultimate judgment of obviousness is a legal determination," the Court held, it may properly be decided on summary judgment. *Ibid.* In particular, "where . . . the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate." *Ibid.*

B. The Claimed Invention.

The patent at issue, U.S. Patent No. 6,880,612 (the '612 Patent), is reprinted in full in Volume 2 of

the Appendix, App. II-1 through App. II-34. The '612 Patent claims a "reduced visibility insect screen" that it is conceded could have been made at the time simply by taking commercially available wire mesh, painting it black, and placing it in a frame in a door or window.

Respondent Andersen asserts eight claims of the '612 Patent against Petitioners Pella and Gore: 22-24, 27-28, 59, 65, and 76. Representative Claim 22 defines the invention as follows:

> An insect screening material in a fenestration unit [*e.g.*, a door or window] that permits ventilation therethrough having reduced visibility, comprising a plurality of screen elements having a diameter of 0.007 inch or less, the screen elements having a tensile strength greater than 5500 psi, wherein the screening has a transmittance of light of at least 0.75 and a reflectance of light of 0.04 or less.

App. II-32, Claim 22. The district court construed "insect screening" to mean simply "a mesh of thin linear elements permitting ventilation while excluding insects" (App. 41), and Andersen did not appeal that construction.

C. The Undisputed Record On The *Graham* Factors.

The factual record is undisputed on all three of the objective factors that underlie the obviousness inquiry set by *Graham*, 383 U.S. at 17.

1. Scope and content of the prior art. The prior art in this case is a wire mesh screen made by a supplier named TWP, Inc. Andersen cited the TWP screen as prior art to the United States Patent & Trademark Office in the application for the '612 Patent, and the patent examiner relied on the TWP screen as prior art. App. II-2, JA00188.[1] The screen was described on TWP's website as an "'optical grade' precision stainless steel mesh[]" that had "high transparency." App. II-35. It was advertised as useful for applications that required people to be able to see through the screen, such as in "shielded windows and cathode ray tubes (CRT's)." App. II-35. In addition, the website printed the technical specifications of the screen in a chart titled "High Transparency Wire Mesh Data," which showed that the screen had 50 strands of wire per inch, a wire diameter of 0.0012 inches, a grid size of 0.0188 inches, and an open area of 88% (App. II-35) – all characteristics that fall within the dimension ranges claimed by the '612 Patent.

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[1] Because this case presents a candidate for summary disposition, Petitioners include factual citations, which refer to the Joint Appendix in the Court of Appeals.

2. Differences between the prior art and the claimed invention. It is undisputed that only three differences separate the unmodified stainless steel screen advertised on TWP's website and the insect screen claimed by the '612 Patent: (1) placement in a frame in a window or door; (2) a reflectance value of 0.04 or less; and (3) bonding of the screen elements at their intersections. App. 8, 26.

It is also undisputed that (a) painting the TWP screen black to reduce its reflectance and bond its wire elements at their intersections and (b) placing it in a frame in a door or window eliminates all of the differences and results in an insect screen that falls within the asserted claims of the '612 Patent. App. 27. The '612 Patent itself lists five variations of darkened TWP screen in Table 1 and calls them preferred embodiments of the invention in the accompanying text. App. II-28-29, 31 and Table 1.

Indeed, buying TWP screen off the Internet and painting it black is how Andersen made the claimed "invention." Employees of an Andersen subsidiary ordered a sample of the TWP screen after seeing it on TWP's website. JA04635. When it arrived, they recognized that "you could see almost like through it and it almost wasn't there." JA04636; *see also* JA04680, JA04799. They put a section of the TWP screening into a frame. JA04637. Then, knowing that other insect screens were colored black to reduce reflectance, they painted the TWP screen black. JA04621, JA04637-38, JA04783, JA04798.

3. The Level Of Ordinary Skill In The Art. The parties agreed, for purposes of the summary judgment motion, that a person of ordinary skill in the art was "someone who manufactures insect screens with no understanding of optics and physics." App. 25. This person of ordinary skill concededly would know to place a wire screen in a frame to make an insect screen. Indeed, Andersen's own experts admitted that placing insect screening in a frame in a window or door was "well known" in the industry (JA04463) and a matter of "commonsense" (JA04554-55). The patent examiner likewise stated that "[i]t would have been obvious, if not inherent to place the presently disclosed screen material in a frame." JA00188.

The person of ordinary skill also concededly would know to use black paint and other methods of darkening a screen to reduce the screen's glare and bond its elements, because doing so was commonplace in the insect screen industry. As Andersen's expert testified, "in 2000 in the industry a *known combination* to a person of ordinary skill in the art facing the problem of reducing the visibility of an insect screening would be to increase the open area of the mesh and then paint it black to give it a low reflectance and provide a bond." JA04462-63 (emphasis added); *see also* JA05530-31, JA04621, JA04629-30, JA04783. The '612 Patent itself acknowledged that darkening screens was well known in the industry, stating that existing "products on the market advertise a black or

charcoal colored screen mesh." App. II-25, col. 1:52-56.

D. Proceedings In The PTO And The Lower Courts.

The patent examiner initially rejected Andersen's application for the '612 Patent as obvious based on the TWP screen, declaring that "[i]t would have been obvious, if not inherent to place the presently disclosed screen material in a frame and to further coat it with a [black] color, as suggested by" a prior art patent before the examiner. JA00188. Responding to the rejection, Andersen argued under pre-*KSR* authority that the cited prior art references did not contain the required "teaching or suggestion" to darken the TWP screening to reduce its reflectance. JA00209-10. The examiner then withdrew the objection, agreeing that the prior art did not expressly disclose a teaching to use screening like the TWP screen as an insect screen in windows and doors:

> The prior art does not disclose the screen material which has the structure recited which is used as an insect screen, which is claimed by way of reciting either the screen in combination with the structure of a fenestration unit or building structure or by reciting the method of using the screen material.

JA00269.

Immediately after the '612 Patent issued, Andersen sued its competitor, Petitioner Pella Corporation,

and Pella's supplier, Petitioner W.L. Gore & Associates, Inc., for alleged infringement. Pella's allegedly infringing product[2] is its Vivid View insect screen, which is made from a unique polymer developed by Gore for use in insect screens. JA04632-33, JA07165, JA04661, JA04662. The polymer material allows the screen to bounce back into its original shape after distortion, unlike metal screens in which defects like tearing and denting make the mesh easier to see. JA06833-34, JA06820-23. Although Andersen made only the TWP wire-screen embodiments of its claimed "invention," the claims of the '612 Patent are extremely broad. They make a blanket claim to *every* screen with "elements having a diameter of 0.007 inch or less, the screen elements having a tensile strength greater than 5500 psi," where "the screening has a transmittance of light of at least 0.75 and a reflectance of light of 0.04 or less" – regardless of what material the screen is made of. App. II-32, Claim 22.

Pella and Gore first moved for summary judgment of obviousness before this Court issued its decision in *KSR*. Bound by the Federal Circuit's precedent, the district court denied the motion. App. 23. After *KSR* issued, however, Pella and Gore moved to reopen summary judgment, and the district court agreed to accept supplemental briefing. After hearing

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[2] The issue of infringement is disputed, and neither party moved for summary judgment on the issue.

argument, the district court applied *KSR* and granted summary judgment holding the asserted claims of the '612 Patent invalid as obvious. App. 32.

The district court assessed the three primary factors set by this Court in *Graham* v. *John Deere Co. of Kansas City*, 383 U.S. 1 (1966), and determined that there were no disputed material issues of fact affecting any of the factors. Regarding the scope and content of the prior art, the district court found that "TWP has been available on the internet, and was in use well before the application for the patent in suit. As such, this material is a major portion of, and was cited as, prior art in the patent's application." App. 25-26. On the second factor, the district court found that, as described above, three differences separated the claimed invention from "the TWP material itself: reflectance value, bonding, and placement in a window frame," and that painting the screen black and framing it eliminated those differences. App. 26. Finally, the court found that "the parties agree that one of ordinary skill in the pertinent art is someone who manufactures insect screens with no understanding of optics and physics." App. 25.

Applying this Court's principle that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," App. 26 (quoting *KSR*, 550 U.S. at 416), the district court held the claimed insect screen obvious. As this Court did in *KSR*, the district court held that the claimed invention was so clearly obvious based on the three primary *Graham*

factors that Andersen's arguments based on secondary considerations such as alleged copying, long-felt need, and commercial success did not create an issue of fact precluding summary judgment. App. 31.

The Court of Appeals for the Federal Circuit, however, vacated the grant of summary judgment. The Federal Circuit agreed "with the district court that Andersen failed to raise a genuine issue of material fact as to two of the [*Graham*] factors: the differences between the prior art and the claimed invention and the level of skill in the art." App. 8. The court concluded, however, that "there exist genuine issues of material fact as to whether one of skill in the art would have looked to the prior art upon which the district court based its grant of summary judgment of obviousness [*i.e.*, the TWP screen]." App. 2-3.

To support its decision, the Federal Circuit relied on the fact that the TWP mesh had been advertised for use as electromagnetic shielding but not as insect screening. App. 9-10. The court failed to discuss the undisputed fact that the TWP mesh was by definition "insect screening" as that claim term was construed by the District Court. *See* App. 41 (construing "insect screening" as a "mesh of thin linear elements permitting ventilation while excluding insects").

The Federal Circuit also relied on three characteristics of the TWP screen that, in its view, taught away from combining the screen with black paint and a frame to make an insect screen. First, without acknowledging that the TWP screen's tensile strength

was nearly 30 times greater than the tensile strength claimed by the '612 Patent, the court doubted whether the TWP screen was durable enough to be considered for use as an insect screen by a person of ordinary skill in the art. App. 11-12. Second, without acknowledging that the unmodified TWP screen transmitted light better than the '612 Patent's claims required and reflected light approximately the same as they required, the court doubted whether the TWP screen was transparent enough to be considered by one of ordinary skill. App. 12. Finally, without acknowledging that the '612 Patent claims contained no cost limitations, the court found an issue of fact whether the TWP mesh was too expensive to be considered by one of ordinary skill. App. 12-13.

REASONS FOR GRANTING THE PETITION

This case is a candidate for summary disposition under this Court's Rule 16.1 because the factual record is undisputed and the legal reasons the Federal Circuit offered for vacating the district court's grant of summary judgment directly conflict with this Court's decision in *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398 (2007).

First, the Federal Circuit's reliance on "[t]he fact that TWP's use for the mesh was electromagnetic shielding" instead of insect screening (App. 11), directly conflicts with this Court's ruling that it is an "error" to assume "that a person of ordinary skill

attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." *KSR*, 550 U.S. at 420.

Second, the Federal Circuit's reliance on three limitations that the '612 Patent does not claim – "durability, transparency, and price feasibility," (App. 13) – directly conflicts with this Court's ruling that what "matters is the objective reach of the claim. If the claim extends to what is obvious it is invalid under § 103." *KSR*, 550 U.S. at 419.

Third, the Federal Circuit's conclusion that a fact question exists because the website description of the TWP screen as "highly transparent" did "not specify that the mesh was highly transparent *relative to insect screens*" (App. 12 (emphasis added)), directly conflicts with this Court's express holding that the obviousness analysis "*need not* seek out precise teachings directed to the specific subject matter of the challenged claim." *KSR*, 550 U.S. at 418 (emphasis added).

This Court issued *KSR* for the express purpose of correcting the Federal Circuit's erroneous approach to determining obviousness. Yet the decision below repeats the very same errors that *KSR* corrected. The Court should summarily reverse the decision below, or else grant review on the merits, to enforce *KSR* and ensure that the principles of obviousness law that *KSR* established will be applied by the Federal Circuit. *See, e.g., Major League Baseball Players Ass'n*

v. *Garvey*, 532 U.S. 504 (2001) (summarily reversing decision below).

I. The Decision Below Conflicts With This Court's Decision In *KSR*.

Every legal reason offered by the decision below to vacate the district court's grant of summary judgment of obviousness conflicts with this Court's ruling in *KSR*.

A. In conflict with *KSR*, the decision below holds that the use of prior art for one purpose creates an issue of fact whether it is obvious to use the prior art for another purpose.

First, the Federal Circuit's decision conflicts with this Court's holding in *KSR* that it is "error" to assume "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." 550 U.S. at 420.

The Federal Circuit's decision cites this Court's holding (App. 10), then rules directly counter to it, concluding that "[t]he fact that TWP's use for the mesh was electromagnetic shielding and that TWP, a company that manufactures insect screens, did not employ this particular mesh as an insect screen," creates an issue of fact precluding summary judgment. App. 11. This is a clear error of law under *KSR*, which holds that "[c]ommon sense teaches . . .

that familiar items may have obvious uses beyond their primary purposes," *id.*, and "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one." *Id.* at 417. Here, common sense taught that a wire screen that was, concededly, "insect screening" under the District Court's unappealed claim construction and that was also advertised as highly transparent was an obvious starting point for making a reduced visibility insect screen.

B. In conflict with *KSR*, the decision below relies on unclaimed limitations to distinguish the prior art.

The Federal Circuit's conclusion that issues of fact exist based on "durability," "transparency," and "pricing" limitations that the '612 Patent does not claim is clear error and directly conflicts not only with *KSR* but also with the Federal Circuit's own decisions.

It is blackletter law that a patentee cannot rely on unclaimed features to argue that its invention is novel and thus avoid a ruling of obviousness. In assessing obviousness, all that "matters is the objective reach of the claim." *KSR*, 550 U.S. at 419. Drafting claims broadly, as Andersen did, forces the patentee to defend broadly. If the claim as drafted includes *anything* that is obvious, "it is invalid under § 103." *Ibid.* This has been the settled law for years,

both in this Court, *see Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U.S. 477, 487 (1935) ("patentability cannot be premised upon structural elements . . . entirely omitted from the claims"), and in each court of appeals to address the issue, *see Charvat* v. *Commissioner of Patents*, 503 F.2d 138, 152-53 (CADC 1974); *Davies-Young Soap Co.* v. *Nu-Pro Mfg. Co.*, 273 F.2d 454, 456 (CA8 1959); *Reinharts, Inc.* v. *Caterpillar Tractor Co.*, 85 F.2d 628, 633 (CA9 1936) – including the Federal Circuit itself, *see Sjolund* v. *Musland*, 847 F.2d 1573, 1582 (CAFed 1988) (obviousness inquiry must focus on claims and not import other limitations); *Ormco Corp.* v. *Align Technology, Inc.*, 463 F.3d 1299, 1311-12 (CAFed 2006) (arguments based on unclaimed features are immaterial to the obviousness inquiry).

Here, it is undisputed that the extraordinarily broad claims of the '612 Patent covered a material with the durability, transparency, and cost of the TWP screen.

It is undisputed first of all that the TWP screen met the only durability requirement claimed by the '612 Patent. The '612 Patent required a tensile strength for the screen elements of 5500 pounds per square inch (psi) (App. II-32, claim 22; App. II-34, claim 76), and the TWP screen had a tensile strength of 162,000 psi – nearly 30 times greater than the requirement. App. II-29, col. 10:65-67. The Federal Circuit thus clearly erred in finding an issue of fact precluding summary judgment based on durability.

With "transparency," just as with durability, the Federal Circuit's decision clearly erred by relying on a limitation that does not appear in the '612 Patent's claims. The claims of the '612 Patent include three limitations related to transparency: element size, proportion of light transmitted, and proportion of light reflected. It is undisputed that, even before the prior art TWP screen was painted black, it met the first two limitations and nearly met the third. First, the TWP screen's elements were only 0.0012 inch in diameter (App. II-35), well within the Patent's claim of "screen elements having a diameter of 0.007 inch or less" (App. II-32, claim 22). Second, the TWP screen had a light transmittance value of 0.897 (App. II-28, Table 1, sample 6) – well within the Patent's claim of "transmittance of light of at least 0.75" (App. II-32, claim 22). Finally, the TWP screen had a light reflectance value of only 0.044 (App. II-28, Table 1, sample 6) – scarcely outside the "reflectance of light of 0.04 or less" that the '612 Patent claims (App. II-32, claim 22). The concededly obvious step of darkening the TWP screen brought it within the reflectance limitation of the '612 Patent. App. II-28, Table 1, samples 1-5.

The Federal Circuit's decision does not discuss these undisputed facts. Instead, it relies on the prior art Sims Patent, U.S. Patent No. 5,012,041, issued in 1991, saying that Sims created an issue of fact by teaching that a screen whose wires were closely spaced could produce "optical interference, not invisibility." App. 12; JA06365. The '612 Patent, however,

does not limit how closely the wires can be spaced. Its only limitation regarding wire spacing is that they not be spaced too widely (App. II-32, claim 24 (requiring mesh openings "not greater than 0.06 inches")) so that insects do not get through. The wire spacing of the TWP screen satisfies that limitation, and the Federal Circuit erred in creating a different limitation.

The Federal Circuit's decision also directly conflicts with *KSR* by relying on the lack of an express teaching that the TWP screen would be more transparent than existing insect screens in denying summary judgment of obviousness. App. 12 (commenting that the website "does not specify that the mesh was highly transparent *relative to insect screens*") (emphasis added). The whole purpose of this Court's ruling in *KSR* was to clarify that the obviousness analysis "*need not* seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." 550 U.S. at 418 (emphasis added). The decision below is based on a clear legal error.

Finally, on the issue of cost, the Court of Appeals disregarded both *KSR* and its own long-standing precedent when it held that the relatively high cost of the TWP screen taught away from its use an insect screen. Cost does not appear as a limitation in the claims of the '612 Patent. Moreover, it is technical challenge, not business factors such as cost, that drives the obviousness inquiry, as the Federal Circuit

recently affirmed. *Friskit, Inc.* v. *RealNetworks, Inc.*, 2009 WL 59182, at *6 (CAFed Jan. 12, 2009). In *KSR*, this Court expressly rejected the argument that the "expens[e]" of a piece of prior art defeated summary judgment of obviousness by teaching away from its use. 550 U.S. at 425. The Federal Circuit has also repeatedly held that economic viability is not material to the obviousness determination. *In re Farrenkpof*, 713 F.2d 714, 718 (CAFed 1983) ("[t]hat a given combination would not be made by businessmen for economic reasons" is irrelevant to obviousness); *Orthopedic Equipment Co.* v. *United States*, 702 F.2d 1005, 1013 (CAFed 1983); *see also id.* at 1015 (Nies, J., concurring). By relying on the cost of the TWP screen to create an issue of fact regarding the scope of the prior art, the Federal Circuit's decision directly conflicts with this Court's precedent and its own controlling decisions.

II. The Same Need To Reform The Federal Circuit's Approach To Obviousness That Supported Review In *KSR* Compels Review Here, And This Case Is A Good Vehicle For Addressing The Issue.

For several reasons, this case presents an ideal factual vehicle for demonstrating the correct application of *KSR* to resolve a question of obviousness at summary judgment.

First, the Federal Circuit's failure to apply *KSR* is outcome determinative of summary judgment. The

district court, applying the Federal Circuit's pre-*KSR* approach, initially denied summary judgment. After *KSR* issued, it reconsidered and granted summary judgment. The Federal Circuit, reverting to the erroneous approach rejected in *KSR*, vacated the grant of summary judgment. This procedural history makes it plain that applying *KSR* is the sole difference between granting summary judgment of obviousness and denying it.

Second, the facts of this case present an ideal vehicle for the Court to apply *KSR*. The material facts are undisputed and the insect screen claimed by the '612 Patent presents what *KSR* described as the plainest case of obviousness: "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." 550 U.S. at 417. For a person starting with an existing, darkened insect screen, all the '612 Patent did was substitute one commercially available wire screen (the TWP screen) for another. Alternatively, for a person starting with the TWP screen, all the '612 Patent did was apply the known techniques of painting the screen and placing it in a frame. Nothing about making the combination was technically difficult, and the combination produced no unexpected result. If this simplest of inventions cannot be held obvious on summary judgment, *KSR* was decided for naught.

Third, this case presents the opportunity for the Court to clarify that the same analysis *KSR* established for determining whether a person of ordinary

skill would be motivated to combine certain items of prior art to make an invention also applies to determine whether a person of ordinary skill would consider the prior art in the first instance. An item of prior art falls within the scope of the relevant prior art for obviousness if it is either "in the field of the applicant's endeavor or, if not, then [is] reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (CAFed 1992). Before *KSR*, the Federal Circuit linked the test for determining the scope of the relevant prior art to its teaching-suggestion-motivation test for determining the ultimate question of obviousness. The Federal Circuit stated that the analogous art test "begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination," and "[t]he motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis." *In re Kahn*, 441 F.3d 977, 987 and n.3 (CAFed 2006); *see also Alza Corp.* v. *Mylan Labs., Inc.*, 464 F.3d 1286, 1290 (CAFed 2006); *Oetiker*, 977 F.2d at 1446-47 (combining the analogous art and TSM tests). When this Court rejected the Federal Circuit's "rigid approach" to the ultimate obviousness analysis, *KSR*, 550 U.S. at 415, it also foreclosed applying that approach to limit the scope of the relevant prior art that can be considered in the analysis. Granting review in this case would give the Court the opportunity to make that clear.

Fourth, this case will allow the Court to reinforce its holding in KSR that evidence showing flaws in the prior art does not preclude summary judgment unless the prior art is "somehow so flawed that there was no reason to upgrade it." 550 U.S. at 425. Here, of course, there were no flaws in the prior art in relation to the claims of the '612 Patent. *See supra* at I.B. But regardless, it was clear error to deny summary judgment of obviousness on the basis of supposed flaws in "durability, transparency, and price feasibility" (App. 13) without even discussing whether the TWP mesh was so flawed that there was no reason to upgrade it. *See KSR*, 550 U.S. at 425 (rejecting argument that evidence showing the prior art to be "bulky, complex, and expensive" precluded summary judgment). Moreover, since the only modifications necessary to make the TWP screen into the insect screen claimed by the '612 Patent were the known, trivial steps of painting and framing, the Federal Circuit's ultimate holding is clearly erroneous. As a matter of law, the TWP screen was relevant prior art because, "[w]hile the [TWP screen] is not designed specifically for application to the [insect screen] industry many of its characteristics and capabilities are similar to those of respondent's system," *Dann* v. *Johnston*, 425 U.S. 219, 228 (1976), and it is therefore "at the very least [a] pertinent reference[ ]," *Graham*, 383 U.S. at 35.

Finally, there is no need to allow this issue to percolate in the Federal Circuit. The panel made its decision unpublished, indicating that it believes the law is settled. Petitioners sought rehearing en banc,

and it was denied without a single member of the Court of Appeals voting for rehearing. The Federal Circuit either cannot or will not control its own case law. This case is therefore postured exactly as *KSR* was, where the Court granted review of an unpublished decision vacating a grant of summary judgment to correct the law of obviousness. *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398 (2007), *reversing* 119 Fed. Appx. 282 (CAFed 2005). The Court should grant review here as it did there.

CONCLUSION

The petition for a writ of certiorari should be granted.

Dated: March 27, 2009

Respectfully submitted,

HARRY C. MARCUS
JESSICA L. COPELAND
LOCKE LORD BISSELL & LIDDELL LLP
3 World Financial Center
New York, NY 10281
(212) 415-8600
Counsel for Petitioner W.L. Gore & Associates, Inc.

CALVIN L. LITSEY
JAMES W. PORADEK
AARON D. VAN OORT
Counsel of Record
SHAWN T. GORDON
ALEXANDER E. ZUMBULYADIS
FAEGRE & BENSON LLP
90 South Seventh Street
Minneapolis, MN 55402
(612) 766-7000
Counsel for Petitioner Pella Corporation

APPENDIX

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App. 1

300 Fed.Appx. 893

United States Court of Appeals,
Federal Circuit.
ANDERSEN CORPORATION,
Plaintiff/Counterclaim Defendant-Appellant,
v.
PELLA CORPORATION, Defendant-Appellee,
and
W.L. Gore & Associates, Inc.,
Defendant/Counterclaimant-Appellee.
No. 2007-1536.

Nov. 19, 2008.
Rehearing and Rehearing
En Banc Denied Dec. 30, 2008.

Appeal from the United States District Court for the District of Minnesota in 05-CV00824, Chief Judge, James M. Rosenbaum.Ronald J. Schutz, Robins, Kaplan, Miller & Ciresi L.L.P., of Minneapolis, MN, argued for plaintiff/counterclaim defendant-appellant. With him on the brief were Ronald J. Schutz, Becky R. Thorson, David P. Swenson, Busola A. Akinwale and Mary E. Kiedrowski.

Aaron D. Van Oort, Faegre & Benson LLP, of Minneapolis, MN, argued for defendant-appellee. With him on the brief were Calvin L. Litsey, James W. Poradek, Chad Drown and Kevin P. Wagner.

Jessica L. Copeland, Morgan & Finnegan LLP, of New York, NY, argued for defendant/counterclaimant-appellee. With her on the brief was Harry C. Marcus.

Before RADER and SCHALL, Circuit Judges, and ALSUP, District Judge.*

DECISION

SCHALL, Circuit Judge.

Andersen Corporation ("Andersen") appeals from the final judgment of the United States District Court for the District of Minnesota which dismissed Andersen's suit against Pella Corporation ("Pella") and W.L. Gore & Associates, Inc. ("Gore") (together "Appellees") for infringement of independent claims 22 and 76 and dependent claims 12, 23-29, 55, 59, and 65 of Andersen's U.S. Patent No. 6,880,612 (the "'612 patent"). The court entered judgment after determining on summary judgment that the asserted claims of the '612 patent were invalid by reason of obviousness. *See Andersen Corp. v. Pella Corp.*, 500 F.Supp.2d 1192 (D.Minn.2007). Andersen also appeals the district court's dismissal without prejudice of Gore's unresolved counterclaim relating to unasserted claims in the '612 patent, arguing that the dismissal should have been with prejudice.

Because we conclude that there exist genuine issues of material fact as to whether one of skill in the art would have looked to the prior art upon which

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* Honorable William Alsup, District Judge, United States District Court for the Northern District of California, sitting by designation.

the district court based its grant of summary judgment of obviousness, we hold that the district court erred in granting summary judgment of invalidity in favor of Pella and Gore. We therefore *vacate* the judgment dismissing Andersen's complaint and *remand* the case to the district court for further proceedings. We *affirm*, however, the district court's dismissal without prejudice of Gore's counterclaim.

DISCUSSION

I.

The '612 patent claims a reduced visibility insect screen. Conventional insect screens typically consist of thick wires or fibers woven in a grid pattern. Such screens obstruct the view through the windows and doors in which they are installed. The screen claimed in the '612 patent comprises fine, thin wires woven tightly together. The result is a screen more transparent than conventional insect screens. An exemplary claim from the '612 patent is independent claim 76:

> An insect screening material in a frame removably attached to a fenestration unit that permits ventilation therethrough and having reduced visibility, comprising a plurality of screen elements having a diameter of 0.007 inch or less, the screen elements having a tensile strength greater than 5500 psi, wherein the screening has a transmittance of

> light of at least 0.75 and a reflectance of light of .04 or less.

'612 patent, col. 19 l.3-9.

The accused device, a reduced visibility insect screen made by Pella, is sold under the name VividView®. Andersen sued Pella and its supplier Gore alleging that the VividView® device infringes the '612 patent. Gore and Pella asserted affirmative defenses of invalidity and unenforceability, while Gore asserted a counterclaim that each of the claims of the '612 patent is invalid. During discovery, Andersen identified the claims that Pella and Gore allegedly infringed as claims 12, 22-29, 55, 59, 65, and 76. Gore and Pella jointly moved for summary judgment, challenging the validity of the asserted claims of the '612 patent. For its part, Andersen moved for summary judgment on the defenses of Gore and Pella and also on Gore's counterclaim of invalidity. By a September 28, 2008 order, the district court denied all motions for summary judgment.

Just weeks before the scheduled date of trial, Gore and Pella moved to re-open their motions for summary judgment in light of the United States Supreme Court's discussion of the obviousness standard in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007). In *KSR*, the Supreme Court reversed our reversal of the district court's grant of summary judgment of invalidity on the ground of obviousness in favor of KSR. 127 S.Ct. at 1745-46. According to the Court, we applied

too rigidly the requirement that an obviousness challenge demonstrate a teaching, suggestion, and motivation to combine known elements (the "TSM test") and failed to give due weight to the nature of the problem to be solved and common sense. *Id.* at 1741-43.

Taking into consideration *KSR*, the district court granted Gore and Pella's motion to re-open the motions for summary judgment on the limited issue of obviousness, and the court requested further briefing from the parties. In their briefs and at oral argument before the district court, Gore and Pella asserted that the invention claimed in the '612 patent was rendered obvious by an electromagnetic-shielding mesh manufactured by TWP, Inc. ("TWP") in combination with Japanese Patent No. 195646, disclosing a method of coating a screen with light absorbable black color to reduce reflection. These two references were the basis of an obviousness rejection of Andersen's patent application by the United States Patent and Trademark Office ("PTO"). Eventually, however, the application issued as the '612 patent after Andersen overcame the rejection by amending its claims to include the limitation "in a fenestration unit that permits ventilation there through."

Applying the test for obviousness under 35 U.S.C. § 103(a), the district court began with an analysis of the primary obviousness factors delineated in *Graham v. Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966):(1) scope and content of the prior art, (2) the differences between the prior

art and claimed invention, and (3) the level of ordinary skill in the art. *Andersen,* 500 F.Supp.2d at 1195-97. Since the court found that the defendants had made out a prima facie showing of obviousness under these primary factors, it then weighed the secondary considerations of nonobviousness discussed in *Graham,* 383 U.S. at 17-18, 86 S.Ct. 684 including commercial success, long felt but unmet need, and failure of others. *Andersen,* 500 F.Supp.2d at 1197-98. Under the direction of *KSR,* the court rejected "a 'rigid approach,' in favor of an 'expansive and flexible approach' using 'common sense' when assessing whether an invention would have been obvious to a person of ordinary skill in the art." *Andersen,* 500 F.Supp.2d at 1195 (quoting *KSR,* 127 S.Ct. at 1739, 1742-43).

In due course, the district court granted Appellees' motion for summary judgment, holding the asserted claims of Andersen's '612 patent obvious and the patent invalid as a matter of law. *Id.* at 1198. In its discussion of obviousness, the court asked, "[W]ould an insect screen manufacturer of ordinary skill have found it obvious to use the TWP screening material, decrease its reflectance value, bond it, and place it in a window frame?," to which it responded, "The answer, plain and simple is 'Yes.'" *Id.* at 1195. In arriving at this conclusion, the court found that the "heart of Andersen's claimed invention" was the TWP mesh, which had been available on the internet and in use prior to submission of Andersen's patent application, and that it was a "simple act of common sense

– rather than of invention – for an insect screen designer of ordinary skill to look [to it]." *Id.* at 1195-96. The court then considered secondary factors, only to find that they could not rebut the strong prima facie showing of obviousness. *Id.* at 1197.

Andersen filed a Notice of Appeal within 30 days of the summary judgment ruling. However, Gore's pending declaratory judgment counterclaim of invalidity relating to no-longer-asserted claims of the '612 patent prevented the district court's judgment from being final. Gore therefore moved to dismiss its counterclaim without prejudice. Andersen moved to dismiss its own appeal before the district court decided Gore's motion to dismiss. On November 25, 2007, this court denied Andersen's motion to dismiss its own appeal and stayed briefing until the district court addressed Gore's pending motion. On February 21, 2008, the district court granted Gore's motion to dismiss its counterclaim without prejudice, and the parties proceeded to brief their cases on appeal to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1) (2006).

II.

We "review the grant of summary judgment de novo, drawing all reasonable inferences in favor of the non-moving party." *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1323 (Fed.Cir.2002) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986)). Summary

judgment is appropriate "where there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law." *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1116 (Fed.Cir.1985) (en banc).

Andersen argues that the district court erred in granting summary judgment of invalidity by reason of obviousness because it raised genuine issues of material fact with respect to whether one of ordinary skill in the art (here, "someone who manufactures insect screens with no understanding of optics and physics," *Andersen,* 500 F.Supp.2d at 1195) seeking to design an insect screen with reduced visibility would have looked to the TWP mesh. Appellees respond that the district court correctly granted summary judgment in their favor because it would have been obvious to an ordinarily skilled artisan to select TWP mesh – a commercially available highly transparent screening material – as a material appropriate for a reduced visibility insect screen.

We agree with Andersen that genuine issues of material fact exist as to whether it would have been obvious to an insect screen designer of ordinary skill to use the TWP mesh as screening material for a reduced visibility insect screen. We begin, as the district court did, by looking at evidence relating to the primary obviousness factors. We agree with the district court that Andersen failed to raise a genuine issue of material fact as to two of the factors: the differences between the prior art and the claimed invention and the level of skill in the art. We do not

agree, however, with the district court's finding that no genuine issue of material fact exists as to the scope and content of the prior art.

Upon our review of the record in the light most favorable to Andersen, we find support adequate to overcome summary judgment on the question of whether the TWP mesh was outside the scope and content of the prior art. Andersen put forth evidence in the record that, one, the TWP mesh was not part of the insect screen manufacturing field, and, two, an insect screen manufacturer would have read the prior art to teach away from using a mesh with the characteristics possessed by the TWP mesh. This field-of-invention and teaching-away evidence, combined with the deference owed to the PTO's issuance of this patent after reviewing the same prior art references that form the basis of this obviousness challenge, raises a genuine issue of material fact as to whether an ordinarily skilled insect screen designer would have found the combination of the TWP mesh with the other prior art references obvious.

Andersen submitted the TWP website as evidence that the TWP mesh used by Andersen was beyond the field of invention. The TWP website posted links to separate webpages for "Technical Information" pertaining to, among other things, an "Insect screen" and a "High Transparency" screen. The TWP mesh used by Andersen was found, not under the "Insect Screen" link, but under the "High Transparency" screen link. The "High Transparency" webpage described the use of these "optical grade"

meshes as electromagnetic shielding in shielded windows and cathode ray tubes (CRTs). In contrast, the "Insect Screen" webpage noted the "wide range of industrial and commercial applications" available for insect screening and did not include electromagnetic-shielding meshes.

The district court was not persuaded that the advertised use of the TWP mesh removed it from the field of invention. It correctly observed that the TWP mesh's "advertised use [as] electromagnetic shielding . . . does not mean it was not available for other uses." *Andersen,* 500 F.Supp.2d at 1196. Indeed, as the district court noted, *KSR* teaches that common sense might make alternative uses of familiar items obvious and that design incentives and other market forces can prompt variations of a work. *See id.*(citing *KSR,* 127 S.Ct. at 1740, 1742). The court found that common sense and the nature of the problem to be solved would have made it obvious to use the TWP electromagnetic-shielding mesh as an insect screen. *Id.*

While we agree that common sense and the nature of the problem to be solved could lead an insect screen designer to a mesh primarily used for a purpose besides insect screens, we find that in this case Andersen raised a genuine issue of fact as to whether the electromagnetic-shielding mesh would have been part of the field of invention searched by an insect screen designer and whether such an alternative use would have been obvious. *See Para-Ordnance Mfg., Inc. v. SGS Imps. Int'l, Inc.,* 73 F.3d 1085, 1088 (Fed.Cir.1995) ("[W]hether [the prior art]

teaches toward or away from the claimed invention also is a determination of fact."). The fact that TWP's use for the mesh was electromagnetic shielding and that TWP, a company that manufactures insect screens, did not employ this particular mesh as an insect screen suggests that common sense and the nature of the problem to be solved might not have made it obvious to an insect screen designer to try using the mesh as an insect screen.

Andersen also submitted into the record prior art references that taught away from using the TWP mesh as an insect screen. Several prior art references in the record teach that the TWP mesh possessed many characteristics that an ordinary skilled insect screen designer would have viewed as undesirable for an insect screen. Specifically, the record at least raises the question of whether the TWP mesh lacked the durability, transparency, and price feasibility preferred by an insect screen manufacturer designing a reduced visibility insect screen.

Andersen submitted evidence that durability is a desirable characteristic of insect screens because they experience wear and tear from exposure to daily weather conditions and interactions with humans and pets. Appellant's Br. at 36-37. In that regard, the TWP website called the electromagnetic-shielding mesh used by Andersen the "world's most delicate metal fabric" and specified that it requires "great care in handling." The Sims Patent, a prior art reference also before the PTO examiner, teaches that fine mesh should only be removed from the glass panes if it will

not be subject to accidental damage and contact. U.S. Patent No. 5,012,041, col.3 l.51-56 (filed Jun. 22, 1989). According to Andersen, the delicacy of the TWP mesh, its need for special care, and its vulnerability to damage upon contact could discourage an insect screen designer from using it.

Andersen also presented evidence that using TWP mesh in an insect screen would not, relative to conventional screens, heighten its transparency – the main objective of the invention. Appellant's Br. at 38-39. Andersen cites the Sims Patent for its teaching that fine mesh produces optical interference, not invisibility, due to the "distracting effects if . . . the wire grid is too fine." *Id.*, col.1 l.48-53. Evidence that the TWP mesh used by Andersen qualifies as a fine mesh that might be shiny according to the Sims Patent comes from the TWP website, which describes the wire comprising the mesh as "many times finer than a single strand of human hair." This evidence is somewhat contradicted by the fact that the TWP website also advertises this mesh as "highly transparent," but that description does not specify that the mesh was highly transparent relative to insect screens. Given the evidence, a person of ordinary skill in the insect screen art arguably would not think that increasing the number of wires in combination with decreasing the diameters of the wires would yield an insect screen with reduced visibility.

As to the third characteristic, pricing, Andersen's expert, Laurence Armstrong, stated that the TWP mesh was "extraordinarily expensive in comparison

with traditional insect screen material, costing about $75.00 per square foot." It is not unreasonable to suggest that a significant difference in cost could discourage an insect screen designer from using the more expensive mesh.

The district court, however, was not persuaded that this teaching-away evidence presented a genuine issue of material fact. The court acknowledged that the Supreme Court in *KSR* approvingly cited *United States v. Adams,* 383 U.S. 39, 51-52, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966), for the "principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." 127 S.Ct. at 1739-40. The district court, however, found Andersen's evidence of teaching away "disingenuous" in the face of the TWP website's reference to the screen as "highly transparent" and capable of use in "shielded windows." *Andersen,* 500 F.Supp.2d at 1196. In essence, the district court found that the teaching toward evidence outweighed the teaching-away evidence in the record.

We disagree with the district court in its evaluation of the teaching-away evidence. On the whole, we think, the record creates a genuine issue of material fact as to whether the durability, transparency, and pricing of the TWP mesh would have discouraged an ordinarily skilled artisan from incorporating the mesh into an insect screen. Recognizing that the Supreme Court in *KSR* cautioned us to not be too rigid in applying the TSM test, we may still consider

evidence of teachings to combine (and, presumably, not to combine) because, according to the Supreme Court, they "capture[ ] a helpful insight" into the obviousness inquiry. 127 S.Ct. at 1741. Unlike in *KSR* where the Supreme Court concluded that "Teleflex ha[d] not shown anything in the prior art that taught away from the [combination of prior art references]," Andersen has raised a genuine issue of material fact as to whether the prior art taught away from using TWP mesh as an insect screen. *Id.* at 1745.

We also note that, in ruling on summary judgment, the district court was required to view the evidence with an eye towards the burden on Gore and Pella to overcome the deference due to the PTO. As "[t]he Supreme Court stated in *Anderson,* . . . 'in ruling on a motion for summary judgment, the judge must view the evidence presented through the prism of the substantive evidentiary burden.'" *Enzo Biochem, Inc. v. Gen-Probe Inc.,* 424 F.3d 1276, 1284 (Fed.Cir.2005) (quoting *Anderson,* 477 U.S. at 254, 106 S.Ct. 2505). As we have explained, the PTO examiner's issuance of the patent is entitled to deference:

> When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the

> references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1304 (Fed.Cir.2008) (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed.Cir.1984)).

In this case, the TWP mesh is one of many references which Andersen submitted to the PTO during prosecution. Indeed, the prosecution history makes clear that the PTO examiner initially denied claims of the patent application as anticipated by the commercially available TWP mesh and obvious in light of the TWP mesh combined with Japanese Patent No. 195646 describing darkening a framed screen door. Andersen overcame those rejections, however, and the PTO provided the following reason for allowance: "The prior art does not disclose the screen material which has the structure recited which is used as an insect screen. . . ." Unlike in *KSR* where the PTO did not consider the prior art reference that ultimately rendered the patent obvious, 127 S.Ct. at 1729, the PTO examiner in this case considered whether the TWP mesh in combination with other references rendered obvious the application that issued as the '612 patent. In evaluating Gore and Pella's joint motion for summary judgment of patent invalidity on the basis of obviousness, the district court needed to consider the additional burden born by Gore and Pella of overcoming the deference owed to the PTO.

Since we find that the record creates a genuine issue of material fact as to whether the '612 patent was obvious under the primary obviousness factors, we need not examine the secondary obviousness factors in any depth. That aside, we note that Andersen submitted evidence of long-felt need, the failure of others, unexpected results, copying by Gore and Pella, and praise by others. The record includes patent applications by Gore explicitly discussing the long-felt need in the industry for an invisible insect screen. That long-felt need was further illustrated by the fact that, at the time of initial summary judgment motions, Gore had submitted several patent applications in the United States on "Insect Screen with Improved Optical Properties." The record also reflects failure of others in that, for decades, Pella and others tried to minimize visibility of insect screens by alternative methods, but failed. As for unexpected results, in its own patent application, Gore acknowledged the "surprising visual effects of the invention" and unexpected results of the narrowly woven mesh. Andersen also presented evidence of praise by others, including by Pella and Gore. The district court noted that the other secondary factor, commercial success, favored Gore and Pella. *See Andersen,* 500 F.Supp.2d at 1197. Even so, Andersen presented evidence suggesting that the majority of secondary considerations favored dislodging an obviousness determination based on the primary obviousness factors.

Review of the record in the light most favorable to Andersen reveals that Andersen provided sufficient

evidence of nonobviousness to overcome summary judgment.

III.

Andersen also argues that the district court abused its discretion when it dismissed Gore's unresolved counterclaim without prejudice under Rule 41(a) of the Federal Rules of Civil Procedures and that the error was not harmless. Rule 41(a)(2) provides that after an answer or motion for summary judgment has been filed, "an action may be dismissed at the plaintiff's request only by court order, on terms that the court considers proper." Fed.R.Civ.P. 41(a)(2). Andersen contends that Gore failed to take any steps to prosecute its counterclaim, to explain its desire to dismiss its counterclaim, and to provide an excuse for waiting to file its motion to dismiss until after the district court granted summary judgment. Appellant's Br. at 58-60. Andersen's alleged prejudice is that Gore avoided an adverse determination on the merits and essentially received a "do-over." Appellant's Br. at 59.

Because dismissal with or without prejudice is a question of procedure, we apply the law of the regional circuit. *See Intel Corp. & Dell Inc. v. Commonwealth Scientific & Indus. Research Org.*, 455 F.3d 1364, 1369 (Fed.Cir.2006). This case arises out of the Eighth Circuit, and the Eighth Circuit reviews a district court's dismissal without prejudice under Rule 41(a)(2) for abuse of discretion. *Paulucci v. City of Duluth*, 826 F.2d 780, 782-83 (8th Cir.1987). To

determine whether to dismiss with or without prejudice, the district court must consider the appropriate factors, including "whether the party has presented a proper explanation for its desire to dismiss; whether a dismissal would result in a waste of judicial time and effort; whether a dismissal will prejudice the defendants; and whether a dismissal is sought merely to escape an adverse decision or to seek a more favorable forum." *Highway Equip. Co. v. FECO, Ltd.*, 469 F.3d 1027, 1034 (Fed.Cir.2006) (applying Eighth Circuit law).

We see no abuse of discretion in the district court's dismissal without prejudice. The court considered the briefs and memoranda submitted by the parties and found that dismissal without prejudice was proper. Upon applying the *Highway Equipment* factors to the record in this case, we find that the court properly exercised its discretion in finding that those factors favored dismissal without prejudice. In the briefs and memorandum, Gore explained that after entry of summary judgment in favor of Appellees on the invalidity of the asserted claims of the '612 patent, it no longer needed the counterclaim as to the unasserted claims. A dismissal of a declaratory judgment counterclaim as to unasserted claims conserves judicial resources. While the motion was presented relatively late in the proceeding (that is, once the district court granted judgment of invalidity on the asserted claims), Gore explained that Andersen continued to narrow the claims throughout the proceedings, and that once the counterclaim

obstructed a timely resolution of the case through immediate appeal, it entered its motion. Most importantly, Andersen presented no evidence of prejudice besides a fear of a second action on the unasserted claims, and "the mere prospect of a second law suit" does not constitute sufficient legal prejudice to defeat a motion to dismiss without prejudice. *New York, C. & St. L.R. Co. v. Vardaman,* 181 F.2d 769, 770 (8th Cir.1950) (quoting *Cone v. W. Va. Pulp & Paper Co.,* 330 U.S. 212, 217, 67 S.Ct. 752, 91 L.Ed. 849 (1947)). The district court did not abuse its discretion in finding that the *Highway Equip.* factors favored a dismissal without prejudice.

In sum, because we conclude that genuine issues of material fact remain as to obviousness, we vacate the judgment entering summary judgment of invalidity in favor of Appellees and dismissing Andersen's complaint. The case is remanded to the district court for further proceedings. We affirm the court's dismissal without prejudice of Gore's counterclaim.

COSTS

Each party shall bear its own costs.

500 F.Supp.2d 1192

United States District Court,
D. Minnesota.
ANDERSEN CORP.
v.
PELLA CORP. and W.L. Gore & Associates, Inc.
No. 05-CV-824 (JRM/FLN).

July 31, 2007.

Becky R. Thorson, Ronald J. Schutz, Busola A. Akinwale, Mary E. Kiedrowski, Robins Kaplan Miller & Ciresi LLP, Minneapolis, MN, Ana D. Johnson, for Andersen Corp.

Calvin L. Litsey, Chad Drown, James W. Poradek, Kevin P. Wagner, Nina Y. Wang, Faegre & Benson, Lori D. Semke, William J. Tipping, Flynn Gaskins & Bennett, Minneapolis, MN, Allan M. Wheatcraft, W.L. Gore & Associates, Inc., Newark, DE, Christopher K. Hu, David H. Pfeffer, Jessica L. Rando, John T. Gallagher, Morgan & Finnegan, New York City, for Pella Corp. and W.L. Gore & Associates, Inc.

ORDER

ROSENBAUM, Chief Judge.

Plaintiff, Andersen Corp. ("Andersen"), accuses defendants Pella Corp. ("Pella") and W.L. Gore & Associates, Inc. ("Gore"), of infringing its patent covering reduced visibility window screens. Defendants reply that Andersen's patent is invalid for

obviousness. The Court agrees, and in light of *KSR Int'l Co. v. Teleflex, Inc.*, ___ U.S. ___, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007), grants defendants' motion for summary judgment.

I. *Background*

Window screens, which allow air to move while barring insects, are not new inventions. And since there have been window screens, manufacturers have had a continuing interest in making them less visible. Andersen, a window screen manufacturer, assembled a team to design reduced visibility insect screens. During their search for the right material, the team members scoured the internet and came upon the TWP, Inc., website. TWP manufactures a variety of screen/mesh products, some of which it actually advertises as window screens.

Relevant to this case, TWP's website displayed a fine, highly transparent stainless steel mesh (referred to as "TWP"), offered for use as electromagnetic shielding. Members of the Andersen team obtained some of this material, and after painting it black, found it appeared nearly invisible when used as window screening. The idea of putting this fine screen mesh into a fenestration unit – a window or door frame – is the essence of the patent in suit.

Andersen attempted to patent its reduced visibility insect screen, but the Patent Examiner initially denied its application. The Examiner considered Andersen's claims obvious in light of the pre-existing

TWP material, in combination with a Japanese patent disclosing darkening to make screening less visible. Andersen, thereafter, amended its application to include the limitation "in a fenestration unit that permits ventilation there through." With this modification, the U.S. Patent and Trademark Office issued Andersen U.S. Patent No. 6,880,612 ("'612 patent").

Andersen now seeks to prevent Pella and Gore from producing and marketing Pella's Vivid View insect screen, claiming it infringes the '612 patent. In particular, Andersen contends defendants' reduced visibility screen infringes independant claims 22 and 76, and dependant claims 12, 23-29, 55, 59, and 65. Exemplary independent Claim 76 recites:

> An insect screening material in a frame removably attached to a fenestration unit that permits ventilation there through, having a reduced visibility, comprising a plurality of screen elements having a diameter of 0.007 inch or less, the screen elements having a tensile strength greater than 5500 psi, wherein the screening has a transmittance of light of at least .75 and a reflectance of light of .04 or less.[1]

(Def.'s Ex. 1 at 34.) The Court has construed the term "insect screening" in accord with *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384,

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[1] Independant claim 22 is nearly identical to claim 76, without the limitation "in a frame removably attached to" a fenestration unit.

134 L.Ed.2d 577 (1996), to mean "a mesh of thin linear elements permitting ventilation while excluding insects." (Claim Construction Order 3, July 7, 2006).

The Court initially entertained cross-motions for summary judgment. These were denied, by Order, dated September 28, 2006. Subsequent thereto, however, the United States Supreme Court decided *KSR Int'l Co. v. Teleflex, Inc.*, ___ U.S. ___, 127 S.Ct. 1727, 167 L.Ed.2d 705, which clarified the standard for determining obviousness in patent litigation.

Citing the *KSR* decision, defendants moved to reopen their summary judgment motion, arguing the '612 patent is invalid as obvious. The Court permitted rebriefing on the question of obviousness in light of *KSR*. After a review of the briefs and further argument, the Court grants defendants' motion for summary judgment.

II. *Analysis*

A. *Summary Judgment Standard*

Summary judgment is appropriate when there are no material facts in dispute and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56; *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). The party opposing summary judgment may not rest upon the allegations

set forth in its pleadings, but must produce significant probative evidence demonstrating a genuine issue for trial. *See Anderson,* 477 U.S. at 248-49, 106 S.Ct. 2505; *see also Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.,* 988 F.2d 1157, 1164 (Fed.Cir.1993). In its recent decision, the Supreme Court stated that, while a finding of obviousness is based on factual findings, "[t]he ultimate judgment of obviousness is a legal determination." *KSR,* 127 S.Ct. at 1745.

B. *Obviousness*

An issued patent is presumed valid under 35 U.S.C. § 282. Thus, the party challenging a patent bears the burden of showing invalidity by clear and convincing evidence. *Kaufman Co., Inc. v. Lantech, Inc.,* 807 F.2d 970, 973 (Fed.Cir.1986). But a patent may not issue if, in light of the prior art, the invention is obvious to one having ordinary skill in the art to which the patent pertains. 35 U.S.C. § 103(a).

When considering whether a patent is obvious, a court must analyze the factors delineated in *Graham v. John Deere Co. of Kansas City,* 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). *KSR,* 127 S.Ct. at 1734. These are: (1) the scope and content of the prior art; (2) the differences between the prior art and claimed invention; and (3) the level of ordinary skill in the art. *Graham,* 383 U.S. at 17-18, 86 S.Ct. 684; *KSR,* 127 S.Ct. at 1734. If defendants establish a prima facie showing of obviousness under these primary factors,

the court then weighs secondary considerations of nonobviousness, such as commercial success, long felt but unmet need, failure of others, and unexpected results. *Id.*; *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311 (Fed.Cir.2006). *KSR* directed courts facing this question to reject a "rigid approach," in favor of an "expansive and flexible approach" using "common sense" when assessing whether an invention would have been obvious to a person of ordinary skill in the art. *KSR*, 127 S.Ct. at 1739, 1742-43.

1. *Primary Obviousness Factors*

Defendants claim the pre-existing TWP screen includes nearly every aspect of the '612 patent's asserted claims, and Andersen's use and modification of the TWP material would have been obvious to one of ordinary skill in the art of insect screen design. For the purposes of this motion, the parties agree that one of ordinary skill in the pertinent art is someone who manufactures insect screens with no understanding of optics and physics.

Window or door screens are, and have been, common consumer goods for many years. The '612 patent's claimed innovation is the simple incorporation of delicate TWP screening into an insect screen frame. This is the heart of Andersen's claimed invention. TWP has been available on the internet, and was in use well before the application for the patent in suit. As such, this material is a major portion of,

and was cited as, prior art in this patent's application.

The issued patent contains only three limitations not found in the TWP material itself: reflectance value, bonding, and placement in a window frame. (Pl.'s Supp. Br. 5.) TWP screening was extensively discussed in the '612 patent specification as the preferred stainless steel embodiment. Given this information, the Patent Examiner initially rejected the application. It was only after the Examiner added the limitation "in a fenestration unit that permits ventilation there through" that the patent issued.[2]

Thus, in the face of an obviousness challenge, the Court considers: would an insect screen manufacturer of ordinary skill have found it obvious to use the TWP screening material, decrease its reflectance value, bond it, and place it in a window frame? The answer, plain and simple is "Yes."

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR,* 127 S.Ct. at 1739. When one of ordinary skill uses a known technique to improve a device, the use of that technique is obvious when applied to a similar device,

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[2] When the Court considers that this product is part of a window or door screen, the Examiner's added limitation is striking in its triviality. Frankly, the Court cannot conceive of a usable insect screen which does not permit ventilation. This is not, after all, an insect wall.

unless its application is beyond his or her skill. *Id.* at 1740.

The patent's bonding and reflectance limitations are met and accomplished by painting the TWP screen black. This technique was well known in the industry at the time of the invention. Indeed, Andersen does not seem to dispute that painting the material black to decrease the TWP material's reflectance value and bond its wires was obvious. Andersen's own expert testified to this. (Laurence Armstrong Dep., Def.'s Ex. 7 at 24-26).

Andersen ultimately argues that a screen manufacturer of ordinary skill would not think to use TWP screening as an insect screen, and would never dream of putting it in a window frame. Andersen premises its argument on the fact that TWP's previous use had been as electromagnetic shielding, as opposed to insect screening. This argument fails.

"Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR* at 1742. "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one." *Id.* at 1740.

Andersen, as well as other screen manufacturers, wished to reduce visibility of insect screens. The pursuit continues. As such, it was a simple act of

common sense – rather than of invention – for an insect screen designer of ordinary skill to look beyond the common insect screen materials to find a screening material that was harder to see. For someone seeking such material, a look at a publicly accessible website advertising screening and mesh materials for sale is scarcely an act of inventive genius.

TWP is a fine-mesh metal screen. While its advertised use was electromagnetic shielding, that fact does not mean it was not available for other uses. It had simply not been tried as insect screening. But the fact that this had not been done does not make the effort to do so non-obvious and patent-worthy.

Andersen asks the Court to consider that TWP's fine quality mesh teaches away from its use as an insect screen in a window. It seeks to bolster this argument by quoting *KSR,* 127 S.Ct. at 1740, which noted, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." The Court is not persuaded.

The TWP screening was certainly advertised as electromagnetic shielding. But the same website referred to it as a highly transparent screen. TWP was also advertised as capable of use in "shielded windows." It is disingenuous to argue that these references teach away from possible use as reduced visibility screening. The product was made of stainless steel possessing a tensile strength greater than 5500 psi. It is undisputedly a "mesh of thin

linear elements permitting ventilation." (*See* Claim Construction Order 3.) Possessing these qualities, the TWP screen was an obvious candidate for insect screening.

So the Court considers an insect screen designer, ordinarily skilled in the art, looking for reduced visibility screening. He or she types "screen" into a search engine and is directed to a website. Clicking on the website, the ordinarily skilled insect screen designer reads of, and sees, TWP – a commercially available highly transparent screening material. At this point, the Court is constrained to find it obvious that our ordinarily skilled screen designer would attempt to incorporate this material into a window frame.[3]

A person of ordinary skill in the art "is also a person of ordinary creativity, not an automaton." *KSR,* 127 S.Ct. at 1742. Once the screen designer discovered the TWP material, the Court finds it obvious to attempt to place it in a window frame to see if it would actually exclude insects, and being fine gauged, whether it might offer reduced visibility. On

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[3] The parties agree that painting screening material black makes it less visible. This fact is not part of the present invention. Similarly, use of paint as a bonding material was also well known to one of ordinary skill in the art. Finally, the use of material possessing tensile strength of 5500 p.s.i. was also well known. At oral argument, plaintiff's attorney acknowledged that screening material must possess this strength in order to both bar insect access and egress, and give it the strength necessary to permit ordinary consumer use.

these facts, the Court finds defendants have made a strong prima facie showing of obviousness.

2. *Secondary Considerations*

In the face of this prima facie showing, Andersen points to secondary factors such as defendants' long-felt, but unresolved need for reduced visibility screening; the failure of others to develop such screening; and the unexpected results achieved by its invention. Secondary considerations such as these can be "utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham,* 383 U.S. at 17-18, 86 S.Ct. 684.

As an initial matter, the Court cannot credit Andersen's suggestion that Pella's advertisements of its VividView product means anything. The mere fact that a company calls its products "new," or even "revolutionary," is commonplace. The term "virtually invisible" is puffery of the first order. The Court draws nothing from defendants' use of this type of language in their advertisements. Such is the nature of advertising. Boastful phrases in advertisements are aimed at consumers; they prove little or nothing about whether an invention is obvious.

More importantly, *Graham* makes clear that secondary factors are simply one of four factors relevant to obviousness. *Graham,* 383 U.S. at 17-18, 86 S.Ct. 684. Courts are reluctant to allow secondary factors to override a strong determination of obviousness based on primary considerations, even when all

evidence relating to secondary factors is resolved in favor of plaintiff. *See KSR,* 127 S.Ct. at 1745; *Leapfrog Enter. v. Fisher-Price, Inc.,* 485 F.3d 1157, 1162 (Fed.Cir.2007) ("given the strength of the prima facie obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion that [the claim] would have been obvious"); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.,* 464 F.3d 1356, 1371 (Fed.Cir.2006) ("secondary considerations of nonobviousness are insufficient as a matter of law to overcome our conclusion that the evidence *only* supports a legal conclusion that claim 1 would have been obvious") (emphasis in original).

As the Supreme Court in *KSR* stated:

> Where, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.

127 S.Ct. at 1745-46. The three primary considerations are not in dispute here. The parties agree on the scope of the prior art, the differences between the prior art and claimed invention, and the level of skill in the art. And in light of these undisputed factors, the Court has determined that Andersen's invention was obvious. Even assuming Andersen's contentions regarding the secondary factors are true, the Court's determination of obviousness cannot be rebutted by these secondary factors.

Finally, after all of this discussion of the TWP product, the Court must note that it has never been commercially successful. The invention, of course, is not the product. A validly-issued patent reserves to its owner the right to practice the claimed invention. For purposes of this motion, this "invention" is defined in the metes and bounds of independent claims 22 and 76 of the '612 patent. And it is ultimately here where the patent fails for obviousness: The Court finds it was obvious for one of ordinary skill in the art to attempt to incorporate a fine mesh screening which allowed air to move while blocking out insects into a fenestration unit in an effort to obtain a less-visible screen.

III. *Conclusion*

The claims of plaintiff's patent are obvious; thus, the patent is invalid as a matter of law. Accordingly, IT IS ORDERED that:

1. The Court's Order, dated October 2, 2006, [Docket No. 237] is vacated in part, insofar as it touches defendants' motion.

2. Defendants' motion for summary judgment [Docket No. 181] is granted.

This action is dismissed with prejudice.

LET JUDGMENT BE ENTERED ACCORDINGLY.

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
05-CV-0824(JMR/FLN)

Anderson Corporation	)	
	)	
v.	)	ORDER
	)	
Pella Corporation et al.	)	

On October 19, 2007, defendants filed a motion to dismiss its pending counterclaims without prejudice, pursuant to Rule 41(a)(2) of the Federal Rules of Civil Procedure.

Based on a consideration of the briefs and memoranda, the Court has determined dismissal is proper. Accordingly, defendants' motion [Docket No. 382] is granted.

IT IS SO ORDERED.

Dated: February 21, 2008

s/ James M. Rosenbaum
JAMES M. ROSENBAUM
United States Chief
District Judge

UNITED STATES DISTRICT COURT
District of Minnesota

Anderson Corp.

V.

Pella Corp. and W. L. Gore & Associates, Inc.

JUDGMENT IN A CIVIL CASE

Case Number: 05-824 JMR/FL

☐ **Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

☒ **Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered,

IT IS ORDERED AND ADJUDGED THAT:

1. The Court's Order, dated October 2, 2006, is vacated in part, insofar as it touches defendants' motion.

2. Defendants' motion for summary judgment is granted.

3. This action is dismissed with prejudice.

July 31, 2007
Date

RICHARD D. SLETTEN, CLERK

s/ G. Schneider
(By) G. Schneider, Deputy Clerk

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
05-CV-824(JMR/FLN)

Anderson Corp.)
)
v.)
) ORDER
Pella Corp. and W. L. Gore) (Filed Oct. 2, 2006)
& Associates, Inc.

This matter is before the Court on the parties' cross-motions for summary judgment. The Court heard oral argument on September 26, 2006.

Based on the files, records, and proceedings herein, and for the reasons stated at the hearing, IT IS ORDERED that:

1. Defendant's motion for summary judgment is denied [Docket No. 181].

2. Plaintiff's motion for summary judgement is denied [Docket No. 201].

Dated: September 28, 2006

s/ James M. Rosenbaum
JAMES M. ROSENBAUM
United States Chief
District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
Civil No. 05-824 (JMR/FLN)

- - - - - - - - - - - - - - -

Andersen Corporation,
Plaintiff,

-v-

Pella Corporation, et al.,
Defendants.

Motion Hearing
September 26, 2006

- - - - - - - - - - - - - - -

TRANSCRIPT OF PROCEEDINGS
HAD BEFORE THE
HONORABLE JAMES M. ROSENBAUM
Minneapolis, Minnesota

Reported By: Dawn M. H. Hansen, RMR-CRR
1005 U.S. Courthouse
300 S. Fourth Street
Minneapolis, MN 55402

* * *

[36] MR. SCHUTZ: I think if the Court has no other questions, I appreciate the time.

THE COURT: I have none, and I thank you.

MR. SCHUTZ: Thank you.

THE COURT: The Court is of a mind that there are unresolved issues of law and fact which

mitigate against summary judgment, and the Court declines to grant summary judgment.

* * *

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
05-CV-824 (JMR/FLN)

Anderson Corp.	) FINAL ORDER
	) of CLAIM
v.	) CONSTRUCTION
Pella Corp. and W.L. Gore & Associates, Inc.	) (Filed Aug. 30, 2006)

The Court has considered the parties' responses to its Preliminary Claim Construction filed July 7, 2006 [Docket No. 150]. Plaintiff objects to the Court's construction, and asks the Court to rule that the term "in a fenestration unit" limits each of the claims of U.S. Patent No. 6,880,612 (the '612 patent). [Docket No. 168].

Upon consideration, the Court presently finds it appropriate to maintain its previous claim construction.

IT IS SO ORDERED.

Dated: August 29, 2006

s/ James M. Rosenbaum
JAMES M. ROSENBAUM
United States Chief District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
05-CV-824 (JMR/FLN)

Anderson Corp.	)	PRELIMINARY CLAIM CONSTRUCTION
v.	)	
Pella Corp. W.L. Gore & Associates, Inc.	)	(Filed Jul. 7, 2006)

This matter is before the Court on the parties' motions for claim construction of U.S. Patent No. 6,880,612 (the '612 patent).

I. Background

Pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), the parties seek the Court's construction of the following disputed terms in the '612 patent:

a) "has/having a transmittance of light of at least [stated value] and a reflectance of light of [stated value] or less," from Claims 22 and 76;

b) "insect screening," from Claims 22 and 76.

II. Analysis

In construing claims, the Court "focuses at the outset on how the patentee used the claim term in the claims, specification and prosecution history," which are the intrinsic evidence of record. *Phillips v. AWH*

Corp., 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc). Terms are presumed to carry "the meaning that the term would have to a person of ordinary skill in the art at the time of the invention." *Id.* at 1313. The specification is the "single best guide to the meaning of a disputed term." *Id.* at 1315. The Court must guard against importing limitations from the specification into the claim. *Id.* at 1322-23. Furthermore, the claims are to be construed without regard to the accused product, *Jurgens v. McKasy,* 927 F.2d 1552, 1562 (Fed. Cir. 1991).

The Court must further consider whether any material was surrendered in the patent process. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,* 535 U.S. 722, 733-34 (2002) (prosecution history estoppel is a "rule of patent construction that ensures that claims are interpreted by reference to those that have been cancelled or rejected.") (internal quotations omitted.) A patentee who narrows a claim to obtain a patent disavows patent protection for the broader subject matter. *Id.* at 737. The relevant inquiry is whether a competitor would reasonably believe, based on the applicant's position before the PTO, that the applicant had surrendered the broader subject matter. *Cybor Corp. v. FAS Tech., Inc.,* 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc).

III. Claim Construction

With the Federal Circuit's approach firmly in mind, the Court turns to the construction of the disputed claim terms.

a) has/having a transmittance of light of at least [stated value] and a reflectance of light of [stated value] or less

The Court considers it unnecessary to define the term.

b) insect screening

The Court determines "insect screening" to be "a mesh of thin linear elements permitting ventilation while excluding insects."

IV. Responses

Any party objecting to the Court's preliminary claim construction shall submit alternative language on or before August 7, 2006.

IT IS SO ORDERED.

Dated: July 7, 2006

s/ James M. Rosenbaum
JAMES M. ROSENBAUM
United States Chief District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
05-CV-824 (JMR/FLN)

Anderson Corp.	)	
v.	)	ORDER
Pella Corp. W. L. Gore & Associates, Inc.	)	(Filed May 15, 2006)

Defendants ask the Court to reopen summary judgment briefing on the limited issue of obviousness, in light of the United States Supreme Court's decision in *KSR Intl Corp. v. Teleflex Inc.* 550 U.S. ___ (2007).

Upon consideration, defendant's request is granted. Each party shall have ten (10) days from the date of this Order to submit a brief addressing the issue, not to exceed 10 pages. The trial date will remain in effect.

IT IS SO ORDERED.

Dated: May 15, 2006

s/ James M. Rosenbaum
JAMES M. ROSENBAUM
United States Chief District Judge

Note: This order is nonprecedential.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1536

ANDERSEN CORPORATION,

Plaintiff/Counterclaim Defendant-Appellant,

v.

PELLA CORPORATION,

Defendant-Appellee,

and

W.L. GORE & ASSOCIATES, INC.,

Defendant/ Counterclaimant-Appellee.

Appeal from the United States District Court for the District of Minnesota in case no. 05-CV-00824, Chief Judge James M. Rosenbaum.

ORDER

(Filed Dec. 30, 2008)

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellees, and the petition for rehearing, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 6, 2009.

FOR THE COURT,

/s/ Jan Horbaly [AMT]
Jan Horbaly
Clerk

Dated: 12/30/2008

cc: Ronald J. Schutz
Calvin L. Litsey, Harry C. Marcus